

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Attorney Docket No.: 15033US02

PATENT

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| In the Application of: |) | Electronically Filed on May 21, 2008 |
| |) | |
| Jeyhan Karaoguz, et al. |) | |
| |) | |
| Serial No.: 10/672,601 |) | |
| |) | Examiner: BATES, KEVIN T. |
| Filed: September 26, 2003 |) | |
| |) | Group Art Unit: 2153 |
| For: AUTOMATIC ACCESS AND |) | |
| CONTROL OF MEDIA |) | Confirmation No.: 1971 |
| PERIPHERALS ON A MEDIA |) | |
| EXCHANGE NETWORK |) | |

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

The Applicants request review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reasons stated on the attached sheets.

Respectfully submitted,

Date: May 21, 2008

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REMARKS

The present application includes pending claims 16-49, all of which have been rejected. Claims 16, 19-23, 25, 27, 29-32, 36-39, 41, 43 and 45-47 stand rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. 7,237,029 ("Hino") in view of U.S. 6,446,192 ("Narasimhan"). Claims 17-18, 26, 28, 33-34, 42 and 44 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Hino in view of Narasimhan and U.S. 2004/00030501 ("Krz"). Claims 24 and 40 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Hino in view of Narasimhan and U.S. 6,363,434 ("Eytchison").

The Applicants first turn to the rejection of claims 16, 19-21, 23, 25, 27, 29-32, 35-37, 39, 41, 43 and 45-47 as being rendered unpatentable by Hino and Narasimhan. Independent claim 16 recites, in part, "A method for automatically monitoring at least one media peripheral via a communication network, the method comprising... automatically determining authorization for monitoring of the at least one media peripheral...." Independent claim 32 recites, in part, "One or more circuits for a media processing system supporting automatic monitoring of at least one media peripheral via a communication network, the one or more circuits comprising: one or more processors communicatively coupled to the communication network, the one or more processors operable to, at least... automatically determine authorization for monitoring of the at least one media peripheral."

The Office Action acknowledges that "Hino does not explicitly indicate **automating** the connection to the peripheral." *See* March 19, 2008 Office Action at page 3. *See also* January 31, 2008 Office Action at page 4. Further, the Office Action does not show that Hino describes, teaches or suggests the various automated limitations noted above. *See id.* at page 3. In order to overcome the deficiencies noted above, the Office Action cites Narasimhan at column 5, lines 46-55. *See id.* The Applicants demonstrate, however, that while the portion of Narasimhan relied on by the Office Action merely indicates that usage data may seemingly be automatically collected, it does not describe, teach or suggest, however, at least:

- **automatically** establishing a **communication link** between a first system and at least one media peripheral;
- **automatically** **determining authorization for monitoring** of the at least one media peripheral; and
- **automatically** **monitoring**, by the first system, at least one status parameter of the at least one media peripheral, if the authorization is successful.

See April 21, 2008 Response at pages 9-11.

Narasimhan broadly states that the “network interface chip manages connections from remote clients automatically, requiring no intervention from the device control circuitry” (*see id.* at column 11, lines 21-23), but “**managing**” a connection is **not** the same as “**automatically establishing a connection**,” “**automatically determining authorization**,” or “**automatically monitoring**” if the authorization is successful. *See id.* at page 11.

Narasimhan also discloses that the “network interface chip can be configured to automatically open a client or server socket upon power-up.” *See id.* at column 18, lines 31-33. While a client or server socket may be automatically opened, the Applicants respectfully submit that this does not equate to **automatically** establishing a **communication link between a first system and at least one media peripheral**.” *See id.* at page 11.

As noted above, Hino does not describe, teach or suggest the various automated steps recited in the claims. The Office Action acknowledges as much. *See* March 19, 2008 Office Action at page 3 and January 31, 2008 Office Action at pages 3-4. Further, the portion of Narasimhan that the Office Action relies on also does not describe, teach or suggest these limitations. *See* April 21, 2008 Response at pages 9-11. Even if one were to assume that Narasimhan discloses “a program that automatically connects to the controlled devices and receives status information to monitor these devices,” as asserted by the Office Action at page 4 (but which the Applicants do not assume), the Office Action has not shown that either of the cited references describes, teaches or suggests “**automatically determining authorization**” to monitor a media peripheral and “**automatically monitoring**” at least one status parameter of the media peripheral

if the authorization is successful. *See id.* at pages 11-12. Thus, for at least these reasons, the Applicants respectfully submit that the Office Action **has failed to establish a *prima facie* case of obviousness.**

The current Office Action also states the following:

Hino discloses the steps of establishing a communication link, determining authorization, monitoring, responding. (see the mapping the rejection).

See March 19, 2008 Office Action at page 8. As noted above, however, the current Office Action also acknowledges that "Hino **does not** explicitly indicate automating the connection to the peripheral." *See id.* at page 3 (emphasis added). As detailed above, Hino does not describe, teach or suggest the various automated limitations of the pending claims.

The Office Action goes on to state, however, the following:

Narasimhan is only relied upon to show that there is a benefit into automating the steps of monitoring a device through the network. Narasimhan teaches that instead of having a user initiate all the listed steps, than an [sic] proxy agent located on the client computer can be programmed to automatically access remote peripheral devices and perform monitoring (Column 5, lines 14-20; lines 53-62).

See id. at pages 8-9.

The Office Action cites Narasimhan at column 5, lines 46-55. *See id.* at page 3. As the Applicants demonstrate, this cited portion of Narasimhan states that the client 30, which is connected to the network, can be an "automated application program that collects data from remote devices 34 via the Internet 32," but not the relevant claim limitations. *See* April 21, 2008 Response at pages 10-13.

In addition to citing Narasimhan at column 5, lines 46-55, the Office Action also cites Narasimhan at column 5, lines 14-20 and column 5, lines 55-62. *See* March 19, 2008 Office Action at pages 8-9. The Applicants also demonstrate that these additional cited portions do not describe, teach or suggest the relevant claim limitations. *See* April 21, 2008 Response at pages 13-15.

"To establish a *prima facie* case of obviousness,...the prior art reference (or references when combined) must teach or suggest **all the claim limitations.**" MPEP at § 2142 (emphasis added). The Applicants demonstrate that the Office Action has not shown that Hino and Narasimhan describe, teach or suggest all the claim limitations. See April 21, 2008 Response at pages 8-15. Thus, for at least this reason, the Office Action has not established a *prima facie* case of obviousness with respect to claims 16, 19-21, 23, 25, 27, 29-32, 35-37, 39, 41, 43 and 45-47. As such, the Applicants respectfully request that the rejection of these claims be reconsidered and withdrawn.

The Applicants respectfully request reconsideration of the rejection of the remaining dependent claims for at least the reasons discussed above.

The Applicants respectfully request reconsideration of the claim rejections for at least the reasons discussed above. The Commissioner is authorized to charge any necessary fees, **including the \$510 fee for the Notice of Appeal**, or credit any overpayment to the Deposit Account of McAndrews, Held & Malloy, Account No. 13-0017.

Respectfully submitted,

Date: May 21, 2008

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